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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/440,645	11/16/1999	AVERY FONG	5244-0109-2	3214

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OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.
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ALEXANDRIA, VA 22314

EXAMINER

LESNIEWSKI, VICTOR D

ART UNIT	PAPER NUMBER
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2152

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/08/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/440,645

Applicant(s)

FONG ET AL.

Examiner

Victor Lesniewski

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 October 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,5-10,14-19,23-28 and 32-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,5-10,14-19,23-28 and 32-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>8/18/2006</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The amendment filed 10/11/2006 has been placed of record in the file.
2. Claims 1, 10, 19, and 28 have been amended.
3. Claims 1, 5-10, 14-19, 23-28, and 32-36 are now pending.
4. The applicant's arguments with respect to claims 1, 5-10, 14-19, 23-28, and 32-36 have been fully considered but they are not persuasive. A detailed discussion is set forth below.

Response to Amendment

5. Claims have been amended to show that the log is sent through the network access. The amendment proves a change in scope to the independent claims as the independent claims now explicitly state that sending the log of the monitored data through the network access. However, none of the amended claims show a patentable distinction over the prior art of record. Since some claims have been amended, the rejections of record will be restated below, taking into account the amendments.

Information Disclosure Statement

6. The IDS filed 8/18/2006 has been considered.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1, 7, 8, 10, 16, 17, 19, 25, 26, 28, 34, and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miyachi (U.S. Patent Number 6,108,492) in view of Weiler et al. (U.S. Patent Number 6,026,380), hereinafter referred to as Weiler.

9. Miyachi disclosed a multifunction peripheral that monitors and stores its status information and reports it to a host computer. In an analogous art, Weiler disclosed a method for recording usage information of a peripheral for accounting and billing purposes.

10. Concerning claims 1, 10, 19, and 28, Miyachi did not explicitly state monitoring at least one of a sequence, timing, or frequency of selecting of the plurality of operations. Miyachi does teach monitoring selections of the operations at the operation panel. Clearly a multifunction peripheral such as Miyachi's must monitor user input at the operation panel in order to effectuate the proper operations requested by the user. However, Miyachi is not explicit on monitoring a more specific sequence, timing, or frequency of this user input. This type of monitoring of the peripheral's operation panel was well known in the art, though, as evidenced by Weiler whose system monitors certain sequences of input and also the timing of user input for controlling a peripheral device. It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify the system of Miyachi by adding the ability to monitor at least one of a sequence, timing, or frequency of selecting of the plurality of operations as provided by Weiler. Here the combination satisfies the need for recording usage information in a peripheral device which is inexpensive to install, maintain, and repair. See Weiler, column 1, lines 26-28. This rationale also applies to those dependent claims utilizing the same combination.

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11. Some claims will be discussed together. Those claims which are essentially the same except that they set forth the claimed invention as a method, a computer program product, or an alternative system are rejected under the same rationale applied to the described claim.

12. Line citations in the following section refer to Miyachi unless otherwise noted.

13. Thereby, the combination of Miyachi and Weiler discloses:

- <Claims 1, 10, 19, and 28>

A system comprising: an image forming device having network access (figure 1, MFP 110a, and LAN 100 or PSTN 130) and including an operation panel, the operation panel comprising a plurality of operations to be selected by a user (column 5, lines 27-32); a monitoring unit configured to monitor data of selecting of the plurality of operations of the operation panel by the user, including monitoring at least one of a sequence, timing, or frequency of selecting of the plurality of operations, and to generate a log of the monitored data (column 5, lines 57-65 and Weiler, column 4, lines 48-63), the log of the monitored data being in a form of a map mapping each of key data in a key portion of the map to respective value data in a corresponding value data portion (columns 6-7, table 1); a communicating unit configured to receive the log of the monitored data, and to send the log of the monitored data through the network access (column 10, lines 36-42 and 58-65, and figure 2, items 210, 215, 260, and 265), and wherein the monitoring unit and communicating unit are self-contained in the image forming device prior to any initial external communication connection by the communication unit, and the monitoring unit is configured to generate the log of the monitored data without any initial external

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communication connection by the communicating unit (figure 2, item 110a and column 5, lines 57-65).

- <Claims 7, 16, 25, and 34>

A system according to Claim 1, wherein the key data and the value data in the map both contain string data (columns 6-7, table 1).

- <Claims 8, 17, 26, and 35>

A system according to Claim 7, wherein the value data portion includes plural vectors in which each vector includes an array of strings (columns 6-7, table 1).

Since the combination of Miyachi and Weiler discloses all of the above limitations, claims 1, 7, 8, 10, 16, 17, 19, 25, 26, 28, 34, and 35 are rejected.

14. Claims 5, 6, 9, 14, 15, 18, 23, 24, 27, 32, 33, and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miyachi in view of Weiler, as applied above, further in view of Aikens et al. (U.S. Patent Number 5,414,494), hereinafter referred to as Aikens.

15. The combination of Miyachi and Weiler disclosed a multifunction peripheral that monitors and stores its status information and reports it to a host computer, including sequence, timing, or frequency information of user input. In an analogous art, Aikens disclosed a method for automatically notifying a remote device in response to certain machine conditions of a peripheral.

16. Concerning claims 5, 6, and like claims, the combination of Miyachi and Weiler did not explicitly state such status conditions as a user exiting operation or a number of sessions to be executed. Miyachi sets forth a multitude of status conditions that are monitored by his

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multifunction peripheral but the majority of them are directed to mechanical properties of the apparatus. However, Aikens does explicitly disclose the certain status conditions as claimed as his system is more focused on setting status conditions directly related to the user's session with the machine. It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify the combination of Miyachi and Weiler by adding the ability to utilize such status conditions as a user exiting operation or a number of sessions to be executed as provided by Aikens. Here the combination satisfies the need for the ability to quickly alert a technician at a remote location of a certain status of a peripheral. See Miyachi, column 3, lines 35-42.

17. Concerning claims 9 and like claims, the combination of Miyachi and Weiler did not explicitly state communicating the log of the monitored data by Internet mail. However, Aikens does explicitly disclose this feature as his system provides for the use of email between the peripheral and the remote location. Furthermore, it is noted that although Aikens does not explicitly state use of the Internet, the ability to transfer email over the Internet was well known at the time of the applicant's invention and it would have been a clear extension to the system of Aikens to simply send his email using the Internet. Thus, it would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify the combination of Miyachi and Weiler by adding the ability to communicate the log of the monitored data by Internet mail as provided by Aikens. Again the combination satisfies the need for the ability to quickly alert a technician at a remote location of a certain status of a peripheral. See Miyachi, column 3, lines 35-42.

18. Thereby, the combination of Miyachi, Weiler, and Aikens discloses:

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- <Claims 5, 14, 23, and 32>

A system according to Claim 1, wherein the communicating unit sends the log of the monitored data when the user exits operating the image forming device (Aikens, column 8, lines 24-31).

- <Claims 6, 15, 24, and 33>

A system according to Claim 1, further comprising a setting unit configured to set a number of sessions of the image forming device to be executed by the user prior to the communicating unit communicating the log of the monitored data (Aikens, column 8, lines 24-31).

- <Claims 9, 18, 27, and 36>

A system according to any one of Claims 5-8, wherein the communicating unit communicates the log of the monitored data by Internet mail (Aikens, column 6, lines 33-41 and figure 5, items 11 and "Mail").

Since the combination of Miyachi, Weiler, and Aikens discloses all of the above limitations, claims 5, 6, 9, 14, 15, 18, 23, 24, 27, 32, 33, and 36 are rejected.

Response to Arguments

19. In the remarks, the applicant has argued:

- <Argument 1>

The combination of Miyachi and Weiler does not disclose the features of claim 1 because it does not disclose "an image forming device having network access" as recited in claim 1.

- <Argument 2>

The combination of Miyachi and Weiler does not disclose the features of claim 1 because it does not disclose “the monitoring unit is configured to generate the log of the monitored data without any initial external communication connection by the communicating unit” as recited in claim 1.

- <Argument 3>

The combination of Miyachi and Weiler does not disclose the features of claim 1 because it does not disclose “monitoring at least one of a sequence, timing, or frequency of selecting of the plurality of operations” as recited in claim 1.

20. In response to argument 1, the combination of Miyachi and Weiler does disclose the device having network access as recited in claim 1. Figure 1 of Miyachi clearly shows the MFP 110a connected to a network (either LAN 100 or PSTN 130) via host 110b. Thus, the MFP 110a can in fact communicate with the network workstation 150 or the remote computer 170. The applicant’s statement that the MFP “cannot directly communicate” with the workstation or remote computer is not relevant as the claim only states that the device has network access.

21. In response to argument 2, the combination of Miyachi and Weiler does disclose generating the log as recited in claim 1. The previous line citation to Miyachi, column 5, lines 57-65, shows that the MFP’s processor is responsible for monitoring conditions and updating the table. There is no mention of an external communication needed as the MFP’s processor is present within the MFP. The applicant’s statement that the MFP can only send status data if a host request is made is not relevant as sending the data is different from monitoring and logging

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the data. The applicant points to the request step 570 in figure 5, but should note the monitoring and logging steps 520, 530, and 540 that take place separately.

22. In response to argument 3, the combination of Miyachi and Weiler does disclose monitoring at least one of a sequence, timing, or frequency of selecting of the plurality of operations as recited in claim 1. The previous line citation to Weiler, column 4, lines 48-63, shows that usage information for the device is recorded by recording events based on user selection on the device. For example, the device uses input prompts responsive to the sequence of keys pressed. The device also monitors the timing of keys pressed by setting an expiration of time since the last keyboard input.

23. In addition, the applicant has argued that claims rejected under 35 U.S.C. 103, but not explicitly discussed, are allowable based on the above arguments. Thus, claims disclosing similar limitations to the discussed claims and related dependent claims remain rejected under the same reasoning as presented above.

Conclusion

24. The applicant's amendment necessitated the new grounds of rejection presented in this office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). The applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

25. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor Lesniewski whose telephone number is 571-272-3987.

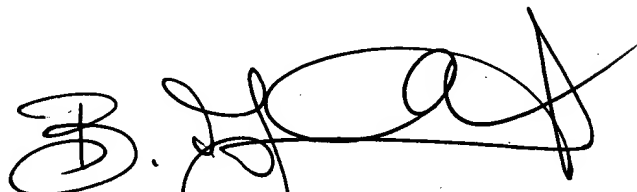
The examiner can normally be reached on Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bunjob Jaroenchonwanit can be reached on 571-272-3913. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Victor Lesniewski
Patent Examiner
Group Art Unit 2152



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